

## REMARKS

### I. Status of the Application

Claims 1-24 are pending in the application and stand rejected. Claims 1-24 are cancelled. New claims 25-39, and the amendments to the specification, are fully supported by the specification, drawings, and claims as originally filed, including, for example, at pages 1-2, paragraphs [0014]-[0020].

Please confirm that the Cross-Reference to Related Applications section added by Preliminary Amendment December 23, 2009 is present, as it is not included in published application No. 2010/0212200.

Applicant requests reconsideration of the claim rejections and re-examination of the application in view of the following remarks.

The nature of the present invention is such that the apparatus can be utilized for storage or transport of a picture or can be utilized for framing a picture. When an individual desires to store or transport a picture framed in the apparatus, the releasable securing means for the framing portions can be released, allowing the framing portions to be unfolded to a substantially flat configuration, prior to the backing portion being releasably secured as a tubular package for the framed picture. Therefore the procedure for packing up the framed picture into a secure arrangement for travel or storage is quick and easy.

Equally, when an individual desires to hang a picture framed in the apparatus on a wall, the backing portion is placed into its unsecured position lying flat, each framing portion is folded into its three-dimensional shape to form a frame, and the framing portion(s) are secured in this position by means of the releasable securing means. This allows a strong and secure frame to be achieved which also improves the aesthetics of the picture.

The ability of the disclosed technology to provide framing products that can be re-used multiple times without damage, reduced strength, or loss of aesthetics is a genuine benefit of substantial commercial value.

## **II. Specification**

The Examiner has noted the CFR guidelines as to the preferred layout for the specification of a utility application pursuant to 37 CFR 1.77(b). Applicant has amended the specification to place it in accordance with the guidelines. No new matter has been submitted. Support for the amendments to the specification can be found throughout the specification as originally filed, specifically, for example, at pages 1-2, paragraphs [0014]-[0020]

## **III. Abstract**

The abstract of the disclosure is objected to because it contains the legal phrase "packaging means". Applicant has amended the abstract, as presented in the Amendments to the Specification, to remove the word "means" and recite "with integral packaging material." No new matter is submitted. Therefore, Applicant respectfully requests that the Examiner withdraw this objection.

## **IV. Drawings**

The drawings are objected to under 37 CFR 1.83(a). Figure 1 has been amended and Figure 3 has been added and Replacement Sheets are submitted herewith. In Figure 1, a backing portion has been added. Additionally, features including a backing portion 8, a flap 9, and a slit 10 have been added. Support for the addition of a backing portion, a flap, and a slit, can be found throughout the specification as originally filed, including, for example, at pages 1-2, paragraphs [0014]-[0020]. The amendments to Figure 1 introduce no new matter.

Figure 3 has been added, including specifically a zip 11 and 12. Support for the addition of Figure 3 can be found throughout the specification as originally filed, including, for example, at pages 1-2, paragraphs [0014]-[0020]. The addition of Figure 3 introduces no new matter.

Therefore, Applicant respectfully requests that the Examiner withdraw this objection.

## **V. Claims 17-20**

Claims 17-20 stand rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. While Applicant traverses the rejection, to expedite

prosecution claims 17-20 have been cancelled and this rejection is now moot. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Regarding new claims 25-39, Applicant submits that the packaging means claimed is not a complex technology. Instead, it simply involves allowing flexible backing material to be in a flat conformation when it is used as a backing for the framed picture, and then rolling the flexible backing material into a tube so as to provide a packaging for the framed picture. Releasable securing means, such as tabs or zippers, are used to secure the rolled tube.

The extent to which the invention is disclosed in an enabling manner is assessed by the application as filed as a whole, when read in light of what was already known in the relevant technical fields. From the application as a whole it is clear that the flexible backing material can be rolled up into a tube to form an integral packaging means that protects the picture in storage or transit. This flexible backing material may have the framing portions attached thereto using any means known by one of skill in the art, for example, adhesive. See paragraph [0015] of the pending application.

Accordingly, it is submitted that the invention as defined in the new claims is described in the application as filed sufficiently clearly so that the skilled artisan could readily implement the invention. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

## VI. Claim 24

Claim 24 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While Applicant traverses the rejection, to expedite prosecution claim 24 has been cancelled and this rejection is now moot. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

## VII. Claims 1-9, 11-16, and 21-24

Claims 1-9, 11-16 and 21-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Fisher (U.S. Patent 796,310). While Applicant traverses the rejection, to expedite prosecution

claims 1-9, 11-16, and 21-24 have been cancelled and this rejection is now moot. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Regarding new claims 25-39, Fisher fails to disclose a product having a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture.

Fisher also fails to disclose the use of a backing portion which is both a backing portion for a framed picture and a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture. Rather, Fisher discloses a foldable blank for forming picture frames. Fisher fails to disclose a backing portion integral with a framing portion, where the backing portion is provided with a releasable securing means and has a first position in which it can be freely moved from a substantially flat conformation to other conformations and having a second position in which it is releaseably secured into a tubular package.

Therefore, Fisher fails to disclose each and every claim limitation of independent claim 25. Applicant requests reconsideration and withdrawal of the rejection.

### **VIII. Claims 1-8, 15, and 17-21**

Claims 1-8, 15, and 17-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Karr (US Patent 1426649). While Applicant traverses the rejection, to expedite prosecution claims 1-8, 15, and 17-21 have been cancelled and this rejection is now moot. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Regarding new claims 25-39, Karr fails to disclose a product having a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture.

Karr also fails to disclose the use of a backing portion which is both a backing portion for a framed picture and a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture. Rather, Karr discloses a combination folder and picture frame. Karr fails to disclose a backing portion integral with a framing portion, where the backing portion is provided with a releasable securing means and has a first position in which it can be freely moved from a substantially flat conformation to other

conformations and having a second position in which it is releaseably secured into a tubular package.

Therefore, Karr fails to disclose each and every claim limitation of independent claim 25. Applicant requests reconsideration and withdrawal of the rejection.

#### **IX. Claims 1-16 and 21-24**

Claims 1-16 and 21-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Roach (U.S. Patent 2408532). While Applicant traverses the rejection, to expedite prosecution claims 1-16 and 21-24 have been cancelled and this rejection is now moot. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection.

Regarding new claims 25-39, Roach fails to disclose a product having a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture.

Roach also fails to disclose the use of a backing portion which is both a backing portion for a framed picture and a flexible backing that can be rolled up into a tube and releasably secured in that position to form an integral packaging means for a picture. Rather, Roach discloses a collapsible framed display. Roach fails to disclose a backing portion integral with a framing portion, where the backing portion is provided with a releasable securing means and has a first position in which it can be freely moved from a substantially flat conformation to other conformations and having a second position in which it is releaseably secured into a tubular package.

Therefore, Roach fails to disclose each and every claim limitation of independent claim 25. Applicant requests reconsideration and withdrawal of the rejection.

#### **X. Conclusion**

Applicant requests that the amendments as presented above be entered into the referenced patent application, and that the application be reconsidered. Applicant submits that all claims pending in the application are now in condition for allowance.

A petition for a one-month extension of time under 37 C.F.R. 1.136(a) and the accompanying fee are filed herewith. The Commissioner is hereby authorized to charge any such fees or credit any overpayment of fees to Deposit Account No. 19-0733.

Date: November 4, 2010

Erin Bryan  
By: Erin E. Bryan, Reg. No. 65,948  
Customer No. 22910  
Banner & Witcoff, LTD.  
28 State Street, Suite 1800  
Boston, MA 02109  
Phone: (617) 720-9600  
Fax: (618) 720-9601  
e-mail: ebryan@bannerwitcoff.com